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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,051	04/23/2004	Masahiko Ogino	500.36317CV2	8713

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EXAMINER

WEISS, HOWARD

ART UNIT	PAPER NUMBER
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2814

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/830,051	OGINO ET AL	
	Examiner	Art Unit	
	Howard Weiss	2814	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☒ Certified copies of the priority documents have been received in Application No. 09/092,138.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>0305 & 0404</u> . | 6) <input type="checkbox"/> Other: _____ |

Attorney's Docket Number: 500.36317CV2

Filing Date: 4/23/04

Continuing Data: Continuation of 10/134,364 (4/30/02 (ABN) which is a Division of
09/092,138 (6/5/98 now U.S. Patent No. 6,433,440)

Claimed Foreign Priority Date: 6/6/97 (JPX)

Applicant(s): Ogino et al. (Eguchi, Nagai, Ueno, Segawa, Kokaku, Ishii, Anjoh,
Nishimura, Miyazaki, Mita, Okabe)

Examiner: Howard Weiss

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 25 recites the limitation "interconnected foams of the three-dimensional reticular structure" in Lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order

for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Initially, and with respect to Claims 22, 23 and 26, note that a "product by process" claim is directed to the product per se, no matter how actually made. See *In re Thorpe et al.*, 227 USPQ 964 (CAFC, 1985) and the related case law cited therein which make it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. As stated in Thorpe,

even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969); *Buono v. Yankee Maid Dress Corp.*, 77 F.2d 274, 279, 26 USPQ 57, 61 (2d. Cir. 1935).

Note that Applicant has burden of proof in such cases as the above case law makes clear.

4. Claims 20 to 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman (U.S. Patent No. 5,237,205), Schueller (U.S. Patent No. 5,866,949) and Wakana et al. (JP 10-110057 A).

Newman shows most aspects of the instant invention (e.g. Figures 4, 8 and 9) including:

- a wiring layer **20** connected **60,70** to terminals **54** on a semiconductor chip **100**
- a three layered buffer layer comprising a structure **30**, an adhesive layer **34** to bond to said semiconductor chip and an adhesive layer **24** directed to bonding said wiring layer

Newman does not show the wiring layer comprising an insulating layer with a wiring on an insulating layer and the structure in buffer layer comprising a three-dimensional reticular structure. Schueller teaches (e.g. Figure 3C) to have a wiring layer with a wire **83** on an insulating layer **60a** to improve reliability (Column 3 Lines 36 to 40). It would have been obvious to a person of ordinary skill in the art at the time of invention to have a wiring layer with a wire on an insulating layer as taught by Schueller in the device of Newman to improve reliability.

Wakana et al. teach to use three-dimensional reticular material to improve elasticity and retain initial hardness and volume(see Advantage). It would have been obvious to a person of ordinary skill in the art at the time of invention to use three-dimensional reticular material as taught by Wakana et al. in the device of Newman to improve elasticity and retain initial hardness and volume.

As to the grounds of rejection under "Product-by-Process", how the buffer layer is prepared, either by pasting both sides or by some other means, pertains to intermediate process steps which do not affect the final device structure. see MPEP § 2113 which discusses the handling of "product by process" claims.

In reference to the claim language referring to the relaxation of thermal stress during heating and other functional limitations, intended use and other types of functional language must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto* , 136 USPQ 458, 459 (CCPA 1963).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 20 to 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 to 4, 12 and 17 of U.S. Patent No. 6,433,440. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a semiconductor device comprising a wiring layer with an insulating layer and a wiring on the insulating layer, one end of the wiring being connected to terminals on the semiconductor chip and the other end of the wiring being connected to external terminals for connecting to a package substrate, and a three-layered buffer layer bonded to the wiring-formed side of the wiring layer, the buffer layer comprising a structure having interconnected foams or a three-dimensional reticular structure, an adhesive layer provided on the semiconductor chip-facing side of the structure having interconnected foams or the three-dimensional reticular structure, directed to bonding to the semiconductor chip and another adhesive layer provided on the other side of the structure, directed to bonding to the wiring layer.

Response to Arguments

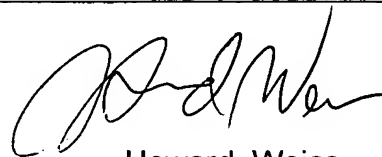
7. Applicant's arguments with respect to Claims 20 to 26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Paper copies of cited U.S. patents and U.S. patent application publications will cease to be mailed to applicants with Office actions as of June 2004. Paper copies of foreign patents and non-patent literature will continue to be included with office actions. These cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. Applicants are referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197 for information on this policy. Requests to restart a period for response due to a missing U.S. patent or patent application publications will not be granted.
9. Papers related to this application may be submitted directly to Art Unit 2814 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The Art Unit 2814 Fax Center number is **(703) 872-9306**. The Art Unit 2814 Fax Center is to be used only for papers related to Art Unit 2814 applications.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard Weiss at **(571) 272-1720** and between the hours of 7:00 AM to 3:00 PM (Eastern Standard Time) Monday through Friday or by e-mail via Howard.Weiss@uspto.gov. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy, can be reached on **(571) 272-1705**.

11. The following list is the Examiner's field of search for the present Office Action:

Field of Search	Date
U.S. Class / Subclass(es): 257/783	5/12/05
Other Documentation: PLUS Analysis Report	3/30/05
Electronic Database(s): EAST, IEL, STNEasy	5/12/05



Howard Weiss
Primary Patent Examiner
Art Unit 2814

HW/hw
13 May 2005